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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,336	01/20/2004	Dennis J. Klein	3780.002	9814

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EXAMINER

WILKINS III, HARRY D

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/760,336

Applicant(s)

KLEIN ET AL.

Examiner

Harry D Wilkins, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 9-20 and 29-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on 05 November 2004 is acknowledged. The traversal is on the ground(s) that the apparatus and method are not distinct. This is not found persuasive because the apparatus *as claimed* can be operated in a different manner, such as that generally described by Rak (US 3,627,133) which produces chlorine gas.

The requirement is still deemed proper and is therefore made FINAL.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/277,841. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the '841 application includes an electrolyzer for separating water including an aqueous electrolyte solution

comprising water partially filling an electrolysis chamber such that a gas reservoir region is formed above the aqueous electrolyte solution, two principal electrodes comprising an anode and cathode being at least partially submerged in the solution, one or more supplemental electrodes at least partially submerged in the solution and interposed between the principal electrodes wherein the two principal electrodes and the one or more supplemental electrodes are held in a fixed spatial relationship and the electrolyzer producing a combustible gas comprising hydrogen and oxygen. Regarding the limitation that the combustible gas has a varying energy content depending on its use, this relates to the manner of operation of the claimed electrolyzer. It is well settled that the manner of operating a device does not differentiate apparatus claims from the prior art. See MPEP 2114. The electrolyzer of the '841 application has an identical structure and, thus, would have been capable of operating in the claimed manner.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. However, a Notice of Allowance was issued in 10/277,841 and mailed on 29 November 2004, but as stated, these claims have not been *patented* yet, merely allowed by the PTO.

4. Claims 21-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No.6,689,259. Although the conflicting claims are not identical, they are not patentably distinct from each other because the hydrogen and oxygen generator of '259 (line 6) is defined in the specification (see col. 5, lines 30-32) as generating hydrogen and oxygen by electrolyzing an electrolyte, i.e.-an electrolyzer. See *In re Vogel* 164 USPQ 622

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regarding use of the specification only as a dictionary to define claim terms. In addition, in claim 5, '259 discloses a filter fluidly coupled to the top portion of the electrolytic reservoir and adapted to remove moisture. Thus, '259 does not disclose the filter means being placed such that the generated hydrogen and oxygen pass through the filter before being drawn for use. However, since the filter of '259 is fluidly coupled to the gas reservoir, the produced gas would necessarily pass through it before being drawn off for use. In addition, while the claims of '259 are silent with respect to the combustible gas having a varying energy content depending on its use, this is a method limitation. The claim of '259 teaches the same structure as is presently claimed, and thus, would have been capable of operating in the claimed fashion. See MPEP 2114. The manner of operating a device does not differentiate apparatus claims from the prior art. Regarding present dependent claims 22-28, each of these claims further limits the manner of operating the electrolyzer system and do not add further structural limitations. Thus, these claims are also met by the welder of the '259 patent.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gonzalez (US 4,450,060).

Gonzalez anticipates the invention as claimed. Gonzalez teaches (see col. 3, line 54 to col. 4, line 3 and figure 1) an electrolyzer for separation of water including an aqueous electrolytic solution comprising water filling an electrolysis chamber such that a gas reservoir region is formed above the solution, two principal electrodes 20 as anode and cathode being immersed in the solution, one or more supplemental electrodes immersed in the solution interposed between the principal electrodes wherein all of the electrodes are held in fixed spatial relationship and the electrolyzer produces a combustible gas of the general formula " $H_xO_y$ ".

Regarding the limitation that the combustible gas has a varying energy content depending on its use, this relates to the manner of operation of the claimed electrolyzer. It is well settled that the manner of operating a device does not differentiate apparatus claims from the prior art. See MPEP 2114. The electrolyzer of Gonzalez has an identical structure and, thus, would have been capable of operating in the claimed manner.

Regarding claims 2-8, each of these claims further limits the manner of operating the electrolyzer system and do not add further structural limitations. Thus, these claims are also met by the electrolyzer of Gonzalez because the electrolyzer of Gonzalez has an identical structure and would have been capable of operating in the claimed manner.

### ***Conclusion***

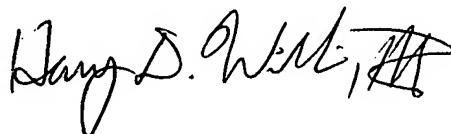
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry D Wilkins, III whose telephone number is 571-272-1251. The examiner can normally be reached on M-Th 10am-8:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harry D Wilkins, III  
Examiner  
Art Unit 1742

hdw

A handwritten signature in black ink, appearing to read "Harry D. Wilkins, III", with a stylized flourish at the end.